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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,896	01/27/1999	SHUJI OTSUKA	102640	6931

25944 7590 03/19/2002

OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 03/19/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/237,896

Applicant(s)

OTSUKA ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 38-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-37 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims 38-46 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 11-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Meister (US Patent No. 5,452,099).

Concerning claims 1-3, 11, 12-16, 22-24, 36-37, Von Meister discloses a facsimile device comprising an image data memory for storing image data; a plurality of memory boxes provided in the image data memory, each of the boxes being accompanied with a predetermined box number and storing first image data therein; a detection device for detecting a transfer command arrived to the facsimile device, specifying a memory box and instructing transfer of the first image data to a calling side; a judgment device for judging whether or not the memory box specified by the transfer command using the box number detected by the detection device is effective; an image transfer device for

transferring the first image data stored in the specified memory box to the calling side when the judgment device judges that the memory box specified by the transfer command is valid and alternatively for transferring second image data different from the first image data to the calling side when the judgment device judges that the memory box specified by the transfer command is not valid (Figs. 1-8; col. 8, line 58 – col. 10, line 53; col. 11, line 59 – col. 12, line 59; col. 13, line 1 – col. 16, line 9); col. 17, lines 5-33).

Von Meister does not directly teach the judgment of the effectiveness of the memory box or of the existence of the memory box. However, Von Meister teaches the judgment whether the memory box is valid or invalid or the memory box is unique or not. It would have been obvious to one skilled in the art at the time the invention was made to consider the judging of the validity of the memory box in Von Meister equivalent to the judging of the effectiveness or existence of the memory box as claimed since both of the processes do the same thing.

Von Meister does not specifically teach that the second image data is sent to the calling side when the memory box stores no image data, wherein the second image data indicating an operational manual. However, Von Meister teaches the step of “explain system operation and prompt for further input” 114 (Fig.2B) and if user ask for further information on the system, it send information explaining in detail system operation and prompt for the caller’s fax number and send more information to the caller (Figs.2B, 2C). In addition, the caller can ask for “detail reporting option” (120, Fig.2B) and the system will send information explaining the call “detail reporting option” or a program to generate monthly reports (Fig.2D), (col. 9, line 12 – col. 10, line 53). It would have been

obvious to one skilled in the art at the time the invention was made to consider the operation manual of the system in Von Meister as the second image data as claimed since the caller can request it in any case he fails to have a communication with the system and the operation manual is different from the first image data stored in the memory. In addition, although Von Meister does not specifically teach that the operation manual includes at least a method of specifying the box number and the identification number or information registered in each of the memory boxes, it would have been obvious to one skilled in the art at the time the invention was made to include the method of specifying the box number and the identification number since the operation manual is supposed to provide instructions to operate the facsimile device.

Concerning claims 4-8, 17-21, 25-35, Von Meister further teaches that the memory box includes a plurality of confidential boxes and non-confidential boxes wherein each of the confidential boxes is accompanied with the box number and an identification number while the non-confidential boxes is accompanied with only the box number; the transfer command includes information of the box number and telephone number of the calling side, and with confidential boxes and additional identification number; the judgment judges whether or not the identification number assigned to the confidential box coincides with the identification number included in the transfer command for confidential box; a message data memory for storing in advance a plurality of message data such as messages indicating that the combination is not unique and have the sender re-enter the security code (Fig. 5), error message (306, Fig. 6A), requesting for inputting the security code again (320, Fig. 6A, 352, Fig. 6C), inputting message number

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again (340, Fig.6B, 804, Fig.7A), generating "message delivered" (362, Fig.6C), (Figs. 1-8; col. 8, line 58 – col. 10, line 53; col. 11, line 59 – col. 12, line 59; col. 13, line 1 – col. 16, line 9); col. 17, lines 5-33).

### *Allowable Subject Matter*

5. Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. \*\*\*

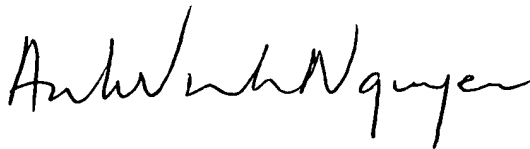
- a. Fuller et al (US Patent No. 5,224,156) discloses a method and apparatus to transmit and receive facsimile data in a confidential manner.
- b. Okada et al (US Patent No. 5,530,739) teaches a mail center management system with mail devices including storage medium for storing mails received from the subscriber terminals.
- c. Kotake et al (US Patent No. 5,263,082) recites a text mail system with a pseudo destination subaddress.
- d. Yoshikawa et al (US Patent No. 6,249,356) discloses a communication terminal device which can receive and transmit confidential data.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622

AV  
March 14, 2002